

REMARKS

This is in response to the Office action mailed April 19, 2007.

The drawings are objected to for failing to comply with 37 C.F.R. 1.84(p)(5) by including a reference number not mentioned in the description. Applicant has submitted herewith replacement drawings amended as suggested by the Examiner. Consideration and acceptance of the proposed new drawings are respectfully requested.

Applicant has amended claim 13 to require the loop to include an upper side received by the handle structure and a lower side attached to the post and form an opening between the upper side and the lower side configured for receiving a hand. Support for the amendment is found in the application as originally filed at page 6, line 26 to page 7, line 5 and in the drawings at FIG. 5. No new matter has been added.

Claims 13-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lehr et al (U.S. Patent Application Publication No. 2002/0167136 A1) in view of McConnell (U.S. Patent No. 2,772,475). Applicant respectfully submits that the Examiner erred in rejecting claims 13-15 under 35 U.S.C. §103(a) by (1) using improper reference combinations which are not suggested by the prior art, and which nevertheless, (2) do not in combination teach or suggest the claimed invention. Accordingly, withdrawal of the §103(a) rejection is respectfully requested.

The question of obviousness under 35 U.S.C. § 103 is a question of law determined according to (1) the scope and content of the prior art, (2) the differences between the claimed invention and the prior art, (3) the level of ordinary skill in the art certain secondary considerations. *See Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966); *Richardson Vicks, Inc. v. Upjohn Co.*, 122 F.3d 1476, 1479, 44 USPQ2d 1181

(Fed. Cir. 1997). Upon review of an Examiner's rejection of an application under §103, the Board makes specific factual findings as to each of the Graham factors, when appropriate. *See Gechter v. Davidson*, 116 F.3d 1454, 1460 n.3, 43 USPQ2d 1030 (Fed. Cir. 1997) (dictum).

The scope and content of the prior art relevant to the invention is determined by (1) whether the art is from the same field of endeavor as the invention, and (2) if not, whether the art is reasonably pertinent to the particular problem with which the inventor is involved. *See In re Oetiker*, 977 F.2d 1443, 1447, 24 USPQ2d 1443 (Fed. Cir. 1992); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058 (Fed. Cir. 1992); *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313 (Fed. Cir. 1986). The purposes of both the invention and the prior art are important in this determination. *See Clay*, 966 F.2d at 659.

If a reference properly falls within the scope of the applicable prior art, then the Examiner's proposed combinations or modifications of prior art must be motivated or suggested by the applied art, the nature of the problem to be solved or the general knowledge of persons of ordinary skill in the art at the time of the invention. *See In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453 (Fed. Cir. 1998). Therefore, that a proposed combination contains all of the elements of the claimed invention is by itself insufficient to support a finding of obviousness. *See id.* These principles are interrelated to the general rule that hindsight may not be used to establish obviousness. *See Kahn v. General Motors Corp.*, 135 F.3d 1472, 1479, 45 USPQ2d 1608 (Fed. Cir. 1998).

In determining the differences between the prior art and the claimed invention, the Examiner must consider whether the invention as a whole would have been obvious at the time of the invention and not whether the differences themselves would have been

obvious. *See Schenck v. Norton Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). Each and every element of the claimed invention must be taught or suggested by the applied art. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Specifically, the Examiner has erred in finding claims 13-15 unpatentable within the meaning of 35 U.S.C. §103(a) over Lehr et al and McConnell by using improper reference combinations which are not suggested in the applied arts. Accordingly, applicant submits that the applied references do not teach or suggest to one of ordinary skill in the art of stability and controlling devices for sport boards to combine the applied art in a manner that would render the claimed invention obvious. *See Rouffet*, 149 F.3d at 1355. The Examiner has not shown reasons why one of ordinary skill in the art, *confronted with the same problems as the inventor* and with no knowledge of the claimed invention, would select the elements from the applied art for combination in the manner proposed. *See id.* at 1357; *see also Kahn*, 135 F.3d at 1480; *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957-58, 43 USPQ2d 1294 (Fed. Cir. 1997); *Lindemann Mach. GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481 (Fed. Cir. 1984) (nothing in the applied art alone or in combination taught or suggested the claimed invention as a solution to the problem the invention addressed).

Lehr et al describe a handle 14 for a sports board 10 secured to the board using snap rivets 22 and a strap 24. Strap 24 is threaded through handle 14, and each snap rivet 22 is inserted through an aperture in an end of strap 24 and a snap post 34 of a runner 16 securing the strap to board 10.

The Examiner acknowledges that Lehr et al do not disclose the strap having a first end and a second end and that the handle is configured to receive the first end of the strap.

The Examiner further acknowledges that Lehr et al do not disclose a buckle configured to receive the first end of the strap and the second end of the strap such that the strap forms a loop when the first end of the strap and the second end of the strap are attached to the buckle and wherein the handle structure is configured to press a hand against the post when the strap is tightened through the buckle. The Examiner thereafter states that it would be obvious to provide a buckle similar to 31 of McConnell to strap 24 of Lehr et al and to provide first and second ends to the strap 24 of Lehr et al similar to the first and second ends to the strap of McConnell so that strap 24 of Lehr et al can be adjusted to press a hand against the post when the strap is tightened through the buckle.

Applicant respectfully submits that, contrary to the assertion of the Examiner, it would not be obvious to modify the sports board handle and strap of Lehr et al by providing a buckle to the strap and first and second ends to the strap, as described by McConnell, so that the strap can be adjusted to press a hand against the post when the strap is tightened through the buckle. More particularly, McConnell describes a grape vine and twine cutting knife including a transversely bowed handle part 8 having an upper surface constituting a hand engaging part 9 and upstanding strap engaging portions adjacent to the ends of the handle. A strap member 30 having a buckle 31 adjustably attached at one end thereof is passed through an opening 12 in the forward strap engaging portion and folded back on itself with the other end of the strap being fed through the rearward strap engaging portion and attached to the buckle providing a two ply strap. In use, the middle finger, ring finger and little finger are inserted between the handle surface 9 and the two plies of strap 30.

McConnell is from a completely different field of endeavor as the present invention and the sports board handles described by Lehr et al, and is not reasonably pertinent to the particular problem with which the applicant is involved, i.e., to provide a stability and controlling device for a sports board. Thus, McConnell in view of Lehr et al does not suggest providing a sports board handle and strap having a buckle and first and second ends to the strap so that the strap can be adjusted to press a hand against the post when the strap is tightened through the buckle. Furthermore, McConnell teaches away from such a combination since McConnell teaches a convex handle part against which a user's hand is pressed. Having a handle, rather than flat base as shown in applicant's claimed invention, would decrease stability. In addition, rather than having a pliable loop that wraps around a user's hand and adjusts to fit snugly there around as described by applicant, McConnell teaches forming an opening between two plies of strap and a rigid handle part surface and then cinching three fingers against the handle part surface by adjusting the two ply strap. Again, McConnell teaches a feature that decreases rather increase stabilization and control. Thus, the skilled artisan would not have relied upon the teachings of McConnell to reach the claimed invention or to solve the problems addressed by the applicant in conceiving and reducing to practice the claimed invention.

Further, while Lehr et al may describe a body board or sports board handle, neither Lehr et al nor McConnell suggests that any of the respective features of one of the described handles should or can be combined with the features of the other handle. For example, Lehr et al nor McConnell makes any mention of providing a buckle similar to the buckle of McConnell to the strap of Lehr et al or providing the first and second ends to the strap of Lehr et al to the first and second ends to the strap of McConnell so that the strap of

Lehr et al can be adjusted to press a hand against the post when the strap is tightened through the buckle. The “mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *In re Gordon et al*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Thus, in absence of any such suggestion, a *prime facie* case of obviousness has not been shown.

Further, even assuming a suggestion to combine the references exists, the references fail to teach or suggest each every feature of the claimed invention. In particular, the claimed invention is directed to body board handle including a post configured to pass through the body board and connect to an anchor, a strap configured to attach to the post, the strap having a first end and a second end, a handle structure configured to receive the first end of the strap, and a buckle configured to receive the first end of the strap and the second end of the strap such that the strap forms a loop when the first end of the strap and the second end of the strap are attached to the buckle. It is a further feature of the claimed invention that the loop includes an upper side received by the handle structure and a lower side attached to the post and forming an opening between the upper side and the lower side configured for receiving a hand wherein the handle structure is configured to press the hand against the post when the strap is tightened through the buckle.

Lehr et al and McConnell, alone or in combination, fail to teach the claimed loop having an upper side received by the handle structure and a lower side attached to the post and forming an opening between the upper side and the lower side configured for receiving a hand. Rather, Lehr et al. describes a strap connected at each to a board, while McConnell describes a two-ply strap connected at each end to a handle part. In each instance, no loop

is formed by a strap and configured to receive a hand. Because the references fail to teach this feature, a *prime facie* case of obviousness has not been shown. Accordingly, withdrawal of the rejection is respectfully requested.

Applicant respectfully requests reconsideration and withdrawal of the rejections, and submits that all of the rejected claims are in a condition for immediate allowance. Should oral discussion facilitate resolution of the outstanding issues, the Applicant encourages the Examiner to contact the undersigned via telephone.

Respectfully submitted,

SIROTE & PERMUTT, P.C.

By:

A handwritten signature in black ink, appearing to read "C. Brandon Browning", followed by a large, stylized flourish or checkmark.

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